THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 62

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKASHI NAKAMURA
and YASUHISA OGAWA

Appeal No. 95-3860
Application 08/109,732[1]

HEARD: November 6, 1998

Before KIMLIN, JOHN D. SMITH and WEIFENBACH, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the

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[1] Application for patent filed August 20, 1993. According to applicants, the application is a continuation of Application 07/730,719, filed July 16, 1991.

final rejection of claims 28 through 32 and 35 through 49. Claims 24 through 27 stand withdrawn from further consideration. Claims 50 and 51 are allowed and claims 33 and 34 are allowable.

The subject matter on appeal is related to a photographic processing method which is said to maintain the various processing solutions in the active state, thus reducing the need to replenish the solutions and reducing the volume of solution which must be disposed of. To illustrate the invention, claim 28 is reproduced below:

28. A photographic processing method wherein a silver halide photosensitive material is developed after exposure with a developer solution and processed with other solutions which include at least one of a first processing solution having a bleaching function and a second processing solution having a fixing function, said method comprising the steps of:

disposing one of said developer solution, said first processing solution and said second processing solution on one side of an anion exchange member and/or disposing one of said first processing solution and an electrolyte solution, which is different from said developer solution, said first processing solution and said second processing solution, on the other side of said membrane, wherein a solution on said one side of said membrane is different from a solution on said other side thereof; and

conducting electricity across said membrane.

No prior art has been cited or applied by the examiner.

Instead, the examiner has rejected the appealed claims under 35 U.S.C. § 101; 35 U.S.C. § 112, first paragraph; and 35 U.S.C. § 112, second paragraph.

We reverse.

Regardless of the statutory basis referred to in the rejections, it is apparently the examiner's concern that the appealed claims are so broadly drafted that they cover embodiments which may be inoperable. Specifically see the answer at pages 5 and 6. Appellants, however, correctly state the law that the possibility of inclusion of inoperative embodiments does not prevent allowance of broad claims. See appellants' substitute brief at page 8. Further, the examiner should be aware that it is not the function of patent claims to specifically exclude possibly inoperative embodiments. In re Geerdes, 491 F.2d 1260, 1265, 180 USPQ 789, 793 (CCPA 1974). As set forth by the court in Geerdes, it is possible to argue that process claims encompass inoperative embodiments "on the premise of unrealistic or vague assumptions," but that is not a valid basis for rejection.

At the oral hearing, the Board raised the issue as to whether or not the "and/or" language that appears in line 8 of

claim 28 renders the claim indefinite. We trust that the appellants and the examiner will address and resolve this matter prior to allowance of this application.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOHN D. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAMERON WEIFFENBACH Administrative Patent Judge	)	

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